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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,425	03/16/2004	Jeremy G. Dunne	LTI0043	2057
25235 7590 03/24/2009 HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEENTH ST DENVER, CO 80202				
EXAMINER				
SAGER, MARK ALAN				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
03/24/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentcolorado@hhlaw.com

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/801,425

**Applicant(s)**

DUNNE ET AL.

**Examiner**

M. Sager

**Art Unit**

3714

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 112(2) claims 26-28 lack of antecedent basis.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-12, 23, 24 and 26-31.

Claim(s) withdrawn from consideration: \_\_\_\_\_

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

/M. Sager/  
Primary Examiner, Art Unit 3714

Continuation of 11, does NOT place the application in condition for allowance because: Regarding the remark on page 7-9 that the final is premature due to all the claims not being drawn to the same invention as required by MPEP 706.07(b) and/or that the Office had applied a new ground of rejection in the final Office action of 11/07/08 as compared to rejections pending in the prior final Office action of 3/21/08, the Office disagrees and maintains final as being proper as explained next so as to enlighten Counsel/Applicant. The record shows submission filed with RCE on 8/21/08 amended claim 23 to include functional steps performed by structure previously claimed by claims 1-12. The step 'storing in said data store said at least one club type and associated representative user range' is same function performed by same structure claimed in claim 1 regarding a data store associated with said instrument and user input for maintaining at least one golf club type and said at least one representative user range as a first correlated data set. Similarly, the step adding determining an inclination to said selected point on said golf course with a tilt sensor in said rangefinding instrument is same function performed by same structure as claimed in claim 4. Likewise, the step of determining a wind speed and direction with a wind speed sensor and directional sensor is same function performed by same structure as claimed in claim 6. Further, the step 'entering other factors in the rangefinding instrument' was claimed by claim 10 for entering a ground condition. Also the language in amended claim 23 'wherein said other factors include at least one of a golf ball type, altitude and barometric pressure' is an optional recitation that is not limiting to the function performed by the structure. MPEP 2111.04. 2114. However, the recitation was treated in final over art previously applied. Hence, the added language including claimed steps performed by cited structure is same claimed by prior claims 1-12. Finally, the structure performing the functions of newly entered claims 26-31 were similarly claimed in claims 1-12. As can be seen, the submission amended claims by further limiting or narrowing claims by structure performing the steps and/or steps performed by the structure as summarized above as particularly claimed therein. Counsel/Applicant argues due to these claim amendments, all of the claims are not directed to the same invention, thereby precluding first action final in the RCE.

As a matter of correctness of record, the requirement, due to the status of this application regards a RCE filing, from MPEP 706.07 states in part 'The claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, and (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114'. Counsel/Applicant opine that amended claim 23 is not the same invention as previously claimed (presumably due to added functional language) and that Claims 26-31 were newly added in the submission thereby that since the claims were not previously pending could not be drawn to same invention, thereby failing to meet requirement (A) of MPEP 706.07(b). As a corollary argument, Counsel asserts that the lack of a statutory double patenting rejection over claims 23 and 26-31 confirms all claims are not the same. However, contrary to this stated interpretation, the Office practice and the case law define same invention to mean patentably indistinct inventions. *Case v. CPC Int'l, Inc.*, 730 F.2d 745 750 221 USPQ 196, 200 (Fed Cir 1984); *Aelony v. Arni*, 547 F. 2d 566, 570 192 USPQ 486, 489-490 (CCPA 1977); *Nitz v. Ehrenreich*, 537 F.2d 539, 543, 190 USPQ 413, 416 (CCPA 1976); *Ex parte Card*, 1904 C.D. 383, 384-85 (Comm'r Pats. 1904). In this case, the narrowing method and instrument by adding of aforementioned claimed steps performed by cited structure therein or adding of claimed structure performing cited function are patentably indistinct from the prior broader method and rangefinding instrument in as much as indicating requirement (A) from MPEP 706.07 was met. This position is further supported by the fact that the Office action found the amended claims to be subject to the identical grounds and art rejections previously of record. Thus, requirement (B) from MPEP 706.07 was met. Further, same invention is as defined above and the presence or absence of a statutory 101 double patenting holding is not evidence whether the claims were claiming same invention. Counsel/Applicant also posits because the Office action has applied a new ground of rejection in the present Final Office action of 11/07/08 as compared to the prior Final Office action, the claims would not have been properly finally rejected on the same grounds of record in the next Office Action if they had been entered in the earlier application as the rejections have been changed as required by criteria (B). Respectively, Counsel/Applicant appears to be confusing the grounds of rejection - the legal basis for denial of patent - with the reasons in support of the grounds of rejection. In this case the legal basis for rejection, or the grounds, did not change. The prior art did not change. The final is proper. To accept the argument by Counsel/Applicant would be tantamount to any amendment of a claim preventing final rejection. Such logic is clearly against the tenants of compact prosecution and the provisions of a fair patent hearing in a timely manner.

In response to argument on page 10-11, that Zeiner-Gundersen fails to teach or suggest a laser rangefinder, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The standard of patentability remains as what the combination of prior art suggests to an artisan when taken as a whole at a time prior to the invention. In this case, when Zeiner-Gundersen in view of Hines (and Wilens or Mauritz, Jenkins or Jones, as applicable) is taken as a whole at a time prior to the invention, it suggests to an artisan a rangefinding instrument and method with a laser rangefinder performing claimed function to provide accurate distance measurement for any distance (Hines, abstract, 1:44-3:22, 8:18, 10:48) in an instructional aid to golfer to use while on golf course so as to improve the advice provided (Zeiner, abstract, 2:13-55), as in final action paragraph 3-7 incorporated herein. The Office agrees Zeiner-Gundersen discloses a laser distance measuring means (3:12-14, 6:43-44) for determining a range to a selected point on a golf course (when the distance is short), but maintains the combination suggests to an artisan a rangefinding instrument and method having a laser rangefinder for determining a range to a selected point on a golf course for any distance on the course so as to increase the advice provided to be for any range.

In reply to remark on page 11-12 that combining Hines with Zeiner-Gundersen renders the latter unsatisfactory for its intended purpose, the Office respectfully disagrees for reasons as stated in evidence in final action paragraph 3-7 as reiterated in summary in evidence next. In summary, Zeiner-Gundersen discloses a golf device for use on a golf course that provides state of golf environment from various sensor inputs that includes a laser distance measuring means (abstract, 2:13-55, 3:6-67, 4:55-57, 5:58-64, 6:43-44, figs 1-5), but lacks laser rangefinder. Hines discloses use of a laser rangefinder on the golf course to provide accurate distant measurement for any distance on

the course (abstract, 1:44-3:22, 8:18, 10:48) for determining a range to a selected point on a golf course. Hines is analogous art at least due to either being in the field of applicant's endeavor or, is reasonably pertinent to the particular problem with which the applicant was concerned of using a laser range-finder to determine range in golf. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill in the art is as representative of the skill level of the aforementioned references. In consideration of US Supreme Court decision in *KSR*, it would have been obvious to an artisan to apply the process of a laser rangefinder as taught by Hines to improve the method and instrument of Zeiner-Gundersen (in view of Wilens, Mauritz, Jones or Jenkins, as applicable) for the predictable result of improved accuracy of distance reading that would also improve club suggestion based on the improved distance reading. Zeiner-Gundersen includes use of laser for determining range that further is evidence that the combination of Zeiner-Gundersen (with Wilens, Mauritz, Jones and Jenkins) and Hines would yield predictable results when an artisan considers the combination as a whole at a time prior to the invention. This alternative holding is with regards to adding a laser rangefinder as taught by Hines to instructional aid of Zeiner-Gundersen to improve distance measurements for longer than short distance so as to improve the advice provided therefrom. Agreeably, Zeiner-Gundersen discusses importance of putting and providing short game assistance and pertains to short distance measurement, but the inclusion of a laser rangefinder as taught by Hines does not render Zeiner-Gundersen unsatisfactory for its intended purpose, but rather instead extends the applicability of the golf instrument to provide golf advice for entire golf course play or to state differently increases the usefulness of advice provided to all facets of golf play due to providing advice for longer than short distances, other shot recommendations apply. Thus, the Office maintains that at a time prior to the invention, the combination of Zeiner-Gundersen in view of Hines (as well as Wilens, Mauritz, Jones and Jenkins) suggests to an artisan a golf instrument having a laser rangefinder (and other sensor/input as suggested by others) to extend the usefulness of the golf instructional aid to other facets of play.

Regarding assertion on page 13 that the proposed modification would change the principle of operation of Zeiner-Gundersen, the Office disagrees for same reasons as stated above incorporated herein in so far as Zeiner-Gundersen in combination with Hines (and Wilens or Mauritz, Jenkins or Jones, as applicable in holding) would extend the usefulness of the golf instruction device by providing advice for longer than short distance measurements in addition to short distance measurements by laser distance measuring means to determine curvature of green with associated device therefrom as taught by Zeiner-Gundersen and via laser range finder as taught by Hines for long (or medium) distance measuring thereby reading and providing advice for shots along the course of any distance rather than only short distance shots, i.e. near the green; thereby increasing the usefulness of the instructional device.

Contrary to remark on page 13-14 that Zeiner-Gundersen teaches away from combination with Hines, the Office disagrees since Zeiner-Gundersen discloses a method but that process does not teach away from what the combination suggests to an artisan when taken as whole at a time prior to the invention. In this case, the Office maintains that the combination when taken as a whole at a time prior to the invention, it suggests to an artisan a rangefinding instrument and method with a laser rangefinder performing claimed functions to provide accurate distance measurement (Hines, abstract, 1:44-3:22, 8:18, 10:48) in an instructional aid to goffer to use while on golf course so as to improve the advice provided (Zeiner, abstract, 2:13-55), as noted in action paragraph 3-7 incorporated herein.

In response to applicant's argument on page 14 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The standard of patentability remains as stated above incorporated herein what the combination of prior art suggests to an artisan when taken as a whole at a time prior to the invention. In this case, when Zeiner-Gundersen in view of Hines (and Wilens or Mauritz, Jenkins or Jones, as applicable) is taken as a whole at a time prior to the invention, it suggests to an artisan a rangefinding instrument and method with a laser rangefinder performing claimed functions to provide accurate distance measurement (Hines, abstract, 1:44-3:22, 8:18, 10:48) in an instructional aid to goffer to use while on golf course so as to improve the advice provided (Zeiner, abstract, 2:13-55), as noted in action paragraph 3-7 incorporated herein.

Regarding remark on page 15 that claim 24 is allowable based on dependency to claim 23, the Office disagrees for reasons stated above incorporated herein.

In reply to remark on page 15 that claims 1-7, 10, 12, 26 and 30 are allowable due to claiming a 'laser rangefinder for determining a range to a selected point on a golf course', the Office disagrees for reasons stated above incorporated herein.

In response to remark on page 16 that claims 8-9 and 11 are allowable based on dependency to claim 1, the Office disagrees for reason stated above incorporated herein.

Regarding remark on page 16 that claims 27-28 are allowable based on dependency to claim 26, the Office disagrees for reasons stated above incorporated herein.

Applicants' admission @ 8:15-9:2 of Amendment, received 11/29/07, regarding computing at least one other correlated data set indicative of another golf club type and associated representative user range based on a relationship in first data correlated data set and computing at least said suggested club type and an associated representative user range for said at least one other club type being well known to an artisan is noted and that the computation is a known calculation such as by table, simple algorithm or similar technique. The lack of criticality of process to compute/enter remaining club data is noted due to instant disclosure relies upon the admitted known process where manner of computing is not critical since cited remarks lists general known process to compute club range.

Thus, contrary to Counsel/Applicant assertions, the totality of Counsel/Applicant remarks is not persuasive since the rangefinding instrument and method is suggested by the combination of references cited in final action so as to increase usefulness of instruction device by providing advice for any distance from either a laser distance measuring means or laser range finder to a point selected by user.